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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,475	01/20/2006	Horst-Werner Maier-Hunke	407-381	9903
<div>7590 10/20/2009</div> <div>Mark P. Stone Attorney at Law 50 Broadway Hawthorne, NY 10532</div> <div>EXAMINER HANSEN, JAMES ORVILLE</div> <div>ART UNIT PAPER NUMBER</div> <div>3637</div> <div>MAIL DATE DELIVERY MODE</div> <div>10/20/2009 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,475

Applicant(s)

MAIER-HUNKE, HORST-WERNER

Examiner

James O. Hansen

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 & 4-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manzardo [US Patent 3,070,235] in view of Chuan [US Patent 5,451,102].

Manzardo (figures 1-27, but specifically figures 18-20) teaches of a key box (fig. 18) having a door (110) and a housing (housing as shown in fig. 18) which can be closed by the door, in which the rear wall (defined by 107's) of the housing is provided with key-hanging means (109, 32), characterized in that side walls (101, 102) and the door of the housing comprises cut-to-length continuous profiles which, in the region of their edges facing away from the door, have vertically running guide grooves (105 for example – also, see fig. 19) for receiving the rear wall, and in that the side walls are attached to a bottom part (103) forming the floor of the box and a top part (104) forming the roof of the box. Manzardo teaches applicant's inventive claimed key box as disclosed above, but does not specifically state that the housing [for the embodiment in figs. 18-20] is made of metal or plastic [Manzardo states "wood" for this embodiment, but does note in the other embodiments that the housing can be made of sheet metal or other material (see col. 2)]; and does not show the top and bottom parts being provided with lugs which jut into cavities in the side walls. As to the employed material, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to utilize a varying array of known materials for the manufacture of the housing depending upon the personal preferences of the designer and/or the designated environment for the finished product since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). As to the lug and cavity connection, Chuan (figures 1-6) is cited as an evidence reference to show that it was known in the furniture art to utilize guide lugs (6) with top and bottom parts (2) in order to connect with cavities (32/33) in side walls (3) so that an assembled cabinet can be constructed. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the cabinet of Manzardo by incorporating the connection system as taught by Chuan because this arrangement would allow the cabinet of Manzardo to be assembled and disassembled in an easy manner [abstract of Chuan]. As to claim 2, the side walls are configured as solid profiles and do not have a hollow portion; however, the position is taken that it would have been an obvious matter of personal preference to vary the shape, profile or size of an element depending upon the needs and/or preferences of the user, since such a modification would have involved a mere change in the configuration of a component. A change of this degree is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of

choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant). Attention is directed to the hollow profiles of Chuan's side walls (fig. 4) as further evidence. Additionally, the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). As to claim 4, Manzardo teaches the side walls and door as being made of wood profiles, but not extruded aluminum; however, the claimed feature is deemed obvious in view of the previously cited rational. As to claim 5, Manzardo teaches the top and bottom parts as being made of wood parts, but not plastic molded parts; however, the claimed feature is deemed obvious in view of the previously cited rational. As to claim 6, the real wall comprises a plurality of segments (viewed as the "segments" (107) between pairs of grooves (109)) disposed one above the other. As to claim 7, the material of the segments appears to be wood, not plastic molded parts; however, the claimed feature is deemed obvious in view of the previously cited rational. As to claim 8, the side walls have flanges (viewed as the end flange behind the groove on each wall – fig. 19) forming parts of the wall. As to claim 9, the side walls have flanges as noted previously and these flanges act as a guide for the segments. As to claim 10, the key hanging means are formed by a key rail (32) which is hung in a perforation or groove (109) in the

real wall. As to claim 11, the top and bottom parts are similarly configured. As to claim 12, the side walls are similarly configured. As to claims 13-20, these limitations/features have been addressed previously within the body of the rejection.

3. Claims 1-9 & 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu [US Patent 6,474,759]. Hsu (figures 1-27) teaches of a "key" box (fig. 6) having a door (7) and a housing (housing as shown in fig. 6) which can be closed by the door, in which the rear wall (4) of the housing is provided with key-hanging means (viewed as the horizontal ledge), characterized in that side walls (2, 3) and the door of the housing comprises continuous profiles which, in the region of their edges facing away from the door, have vertically running guide grooves (34 for example – also, see fig. 1) for receiving the rear wall, and in that the side walls are attached to a bottom part (1) forming the floor of the box and a top part (5) forming the roof of the box. Hsu teaches applicant's inventive claimed "key" box as disclosed above, but does not specifically state that the housing is made of metal or plastic [although, it is readily apparent that the housing is made of a plastic material]. As such, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a varying array of known materials for the manufacture of the housing depending upon the personal preferences of the designer and/or the designated environment for the finished product since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); and *In re Leshin*, 227

F.2d 197, 125 USPQ 416 (CCPA 1960). As to claim 2, the side walls are configured partially as hollow profiles (note fig. 1) so far as broadly claimed. As to claim 3, the top part and bottom part are provided with cavities (15, 11 respectively) while the side walls having mating guide lugs (25, 35; 21, 31 respectively). Hsu teaches this lug to cavity connection, but not as prescribed by applicant [applicant claims the lugs being on the top and bottom parts]. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the box of Hsu so as to reconfigure the elements associated with the top, bottom and side parts/walls since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art and therefore will not distinguish the invention from the prior art in terms of patentability. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with the steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.). As to claim 4, Hsu teaches the side walls and door as being apparently molded profiles, but not extruded aluminum profiles; however, the position is taken that it would have been an obvious matter of personal preference to vary the shape, profile or size of an element depending upon the needs and/or preferences of the user, since such a modification would have involved a mere change in the configuration of a component. A change of this degree is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was

a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant). Furthermore, the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). As to claim 5, Hsu teaches the top and bottom parts as being apparently molded profiles, but not does specifically recite plastic molded parts; however, the claimed feature is deemed obvious in view of the previously cited rational. As to claim 6, the real wall comprises a plurality of segments (viewed as the "segments" (top segment above the horizontal ledge and bottom segment below the ledge) disposed one above the other, so far as broadly claimed. As to claim 7, the material of the segments appears to be plastic molded parts, but just not specifically recited; however, the claimed feature is deemed obvious in view of the previously cited rational. As to claim 8, the side walls have flanges (viewed as the end flange defining the groove on each wall – fig. 1) forming parts of the wall. As to claim 9, the side walls have flanges as noted previously and these flanges act as a guide for the segments. As to claim 11, the top and bottom parts are similarly configured. As to claim 12, the side walls are similarly configured. As to claims 13-20, these limitations/features have been addressed previously within the body of the rejection.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu in view of Manzardo. Hsu teaches applicant's inventive claimed "key" box as disclosed above, but does not show the key hanging means as being a key rail that is hung in perforations in the rear wall. Manzardo (see figs. 16-17) is cited as an evidence reference to show that it was known to utilize a key rail (32) hung in perforations (94) in a rear wall (93) of a key box. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the rear wall of Hsu so as to incorporate perforations for accepting a rail in view of Manzardo's teaching because this arrangement would enhance the versatility of Hsu's box since the addition of the perforations and rail would allow items to be hung on the rear wall, as opposed to be supported by the bottom part or shelf (6), thereby allowing for quick inspection by a user since the items would be suspended vertically along the rear wall.

Response to Arguments

5. Applicant's arguments filed June 15, 2009 have been fully considered but they are not persuasive. As to applicant's remarks concerning Manzardo and amended claim 1, the position is taken that the new limitations {incorporation of guide lugs and cavities} have been considered, but are deemed moot in view of the new grounds of rejection. As to applicant's remarks concerning Hsu and the limitation of a "key-hanging means" as stipulated in claim 1, note the following: the position is taken that the limitation in question does not impart any structural attributes as presently set forth in

the claim and as such, has been given it's most reasonable broad interpretation. As to applicant's remarks concerning the claimed "cut-to-length continuous profiles" with regards to the applied prior art, note the following: the method of forming the device or components of the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the position is taken that a *prima facie* case of obviousness has been established since applicants claimed invention only unites old elements with no change in their respective functions. Common sense directs one to look with care at a patent application that claims as innovation the combination of known devices according to their established functions, as such, the examiner has identified reasons that would have prompted a person of ordinary skill in the art to combine the elements in the same way as the claimed new invention does. Consequently, the rejections are deemed adequate to support the legal conclusion of obviousness.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 571-272-6866. The examiner can normally be reached on Monday-Friday between 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James O. Hansen/
Primary Examiner, Art Unit 3637

JOH
October 19, 2009